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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/675,976	09/29/2000	Keith Shippy	042390.P7957	1732

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EXAMINER

LIPMAN, JACOB

ART UNIT

PAPER NUMBER

2134

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/675,976

Applicant(s)

SHIPPY ET AL.

Examiner

Jacob Lipman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 31-38 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Newly submitted claim 31-38 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The new claims are directed toward a method of establishing a secure method of encrypted communication between computers, while the original claims are directed toward encrypting data prior to transfer, and then later retrieving a decryption key

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 31-38 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Specification

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 3, 11-13, and 19-30 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Regarding claims 3, 11, and 19, the phrase "if necessary" renders the claim indefinite because it is unclear what determines if the limitation is necessary.
6. Claim 19 recites the limitation "encrypts said payload with said at least one decryption key". It is unclear how a decryption key would encrypt, and if it is in-fact an encryption key.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-30, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Cooper et al., US Patent number 5,757,908.

With regard to claims 1, 9, 14, 19 and 21, Cooper discloses a computer (column 3 lines 50-53), which encrypts a payload (column 3 lines 55 -57), replaces a portion of the payload with a tag (column 3 lines 57-63) that identifies a decryption key (column 4 lines 16-20), and sets a flag in a header that indicates that the payload has the tag (column 17 lines 17-23).

With regards to claims 2, 10, and 20, Cooper discloses encrypting the portion (column 3 lines 57-59).

With regard to claims 3 and 16, Cooper discloses the tag includes a data-stream identifier having information to access a key (column 4 lines 10-15).

With regard to claims 4, 6-8, 11-13, 17, 18, 22-25, 27, 29, and 30, Cooper discloses that in response to finding the data block, the file management program loads the decryption key and decrypts the file (column 4 lines 10-22).

With regard to claims 5 and 28, Cooper discloses receiving the data from a third system (column 3 lines 9-15).

With regard to claims 15 and 26, cooper discloses the system can be a network of computers (column 21 lines 12-44).

Response to Arguments

1. Applicant's arguments filed 7/2/2004 have been fully considered but they are not persuasive.

Applicant attempts to add special meaning to known terms. For example, a protected content exchange module would be any module that protects content to be exchanged. An application decoder module is any module that decodes. In Cooper, the first system encrypts the payload to protect the content that it is exchanging, and the second system receives the key and decodes the content.

With regard to claim 1, 9, 14, 19, and 21, applicant argues, "Cooper et al. do not teach a method to re-encrypt a decrypted data stream". The examiner points out that this re-encrypting is never claimed in the claims, and it is unclear what limitation of claim 1 is being referred to here.

With regard to claims 2, 10, and 20, applicant argues that Cooper does not disclose encrypting a portion of the payload. The encrypting step of claim one includes encrypting the entire payload, including the portion.

With regard to claims 3 and 16, applicant argues that in the claims, a tag require a data stream comprising data blocks. The claim defines a tag as including a data stream identifier. Applicant further argues that the file in cooper does not contain data blocks. The examiner first points to the lack of this limitation in the claims, and second points to the definition of data blocks, in Microsoft's Computer Dictionary, as "A collection of consecutive bytes of data that are read or written to a device as a group", which certainly reads as a file.

With regard to claims 4, 6-8, 11-13, 17, 18, 22-25, 27, 29, and 30, applicant suggests that the first and second system negotiate to determine a decryption key. This however is not found in the claims. Instead the claims describe the second system receiving the key from the first system, as Cooper discloses (column 4 lines 7-10).

With regard to claims 5 and 28, applicant argues that Cooper does not disclose receiving a "stream of data", but discloses receiving a software object. Applicant again attempts to add special meaning to known terms. The definition of data stream, in Microsoft's Computer Dictionary, is "An undifferentiated, byte-to-byte flow of data", which certainly reads as a software object.

With regard to claims 15 and 26, applicant argues that Cooper teaches, "a decryption key may be stored on another system on the network, or supplied by a system administrator". Applicant further argues, "Manually supplying a key from an

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administrator does not result in applicant's claimed invention". The examiner agrees, with this last statement, but Cooper clearly states that the files can be downloaded, and suggests that this is not desirable (column 21 lines 12-44). However, art teaching away is not a valid argument for a 102 rejection, and thus Cooper does disclose this method of transferring the data.

Conclusion

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Lipman whose telephone number is 571-272-3738. The examiner can normally be reached on 7:00 - 4:00 (M-Th).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on 571-272-3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JL


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